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09/926,690	12/03/2001	Kenichi Otani	216009US3PCT	9480

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EXAMINER

HECKENBERG JR, DONALD H

ART UNIT

PAPER NUMBER

1722

11

DATE MAILED: 03/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/926,690

Applicant(s)

OTANI ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 December 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3,7,8. 6) ☐ Other: .

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1. Claims 4-5 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 4-5 recite only limitations directed at the intended use of the apparatus described in claim 1. As discussed more fully below, it is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. Therefore, claims 4-5 fail to further limit claim 1.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Granberg (U.S. Pat. No. 4,014,739; previously of record).

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Granberg teaches a papermaking mold comprising a papermaking part of a prescribed shape (18), a peripheral part extending outward from the peripheral edge of the papermaking part (figure 2), and a net (30 and 32) covering the papermaking part and at least part of the peripheral part (figure 2), wherein a fixing member in the form of a mating projection (42b) is integrally fixed to part of the net and covering the peripheral part (figure 2), the fixing member mating in a depression made in the peripheral part to fix the fixing member to the peripheral part (see figure 2, and column 4, line 63 - column 5, line 26).

Claims 4-5 recite that the papermaking mold described in claim 1 is used as paired with another papermaking mold in a manner that the papermaking part of the pair face each other and the fixing member of the pair are brought into contact with each other. Written as such, the claim merely recites an intended use of the apparatus described in claim one, and not any additional structural elements. It is well settled that the intended use of an apparatus is not germane to the issue of patentability of the apparatus. If the prior art structure is capable of performing the claimed use, then it meets the claim limitation(s). In re Casey, 370 F.2d 576, 580 152 USPQ 235, 238 (Cust. & Pat. App. 1967); In re Otto, 312 F.2d 937, 939, 136 USPQ 458, 459 (Cust. &

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Pat. App. 1963). In the instant case, the apparatus of Granberg, as evidenced by figure 1 could be used in a pair with another papermaking mold, thus it meets all of the recited claim limitations.

Claim 6 recites that the peripheral part is disposed at a site where it does not receive a mold clamping force or is not damaged by a mold clamping force. Claim 7 additionally recites that the net is disposed lower than a surface on which mold clamping force is to be exerted. As discussed above, the references in these claims to a mold clamping force, with no corresponding structure providing the clamping force, represent an intended use of the apparatus. As the apparatus of Granberg is capable of being used in an operation wherein a mold clamping force is not applied to the peripheral part (for example, a use where the clamping force is applied to the outer edge of base member 36), Granberg anticipates all of the recited limitations of claims 6-7 as well.

4. Claims 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Greve (U.S. Pat. No. 5,770,016).

Greve teaches a molding apparatus which comprises a molding part (30) of a prescribed shape, a peripheral part (14)

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extending outward from the molding part, a net covering (16) the papermaking part and at least part of the peripheral part.

As discussed above in the rejection in view of Granberg, the mold clamping force refers to an intended use of the apparatus, which is not germane to the issue of patentability. In any event, Greve clearly shows that net (16) covering the peripheral part to be disposed on a surface lower than the surface (15) in which the mold clamping force is to be exerted, and thus the mold clamping force would not damage the part of the net covering the peripheral part (see figures 1 and 7). Note, although Greve does not teach the apparatus to be used to make paper, this too is directed at the intended use of the apparatus. The apparatus of Greve is clearly capable of being used in a paper making process (see column 1, lines 11-58), and thus anticipates claims 6-7.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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6. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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8. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Greve in view of Hatton (U.S. Pat. No. 2,105,593).

Greve teaches the apparatus as described above. Greve further teaches a means for applying a mold clamping force (see figure 2). Greve fails to teach the means for applying a mold clamping force to be adjustable.

Hatton teaches a mold for producing products from wet fibers which is provided with a means for adjusting a mold clamping force (15) in order to allow desired forcing of excess water out of the molding material (see p. 2, column 1, lines 22-26).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Greve as such to have made the means for applying the force adjustable because this would allow for the desired result of excess water being removed from the molding material as suggested by Hatton. Note further, this modification of Greve is an example of making a known part adjustable, which is generally seen as obvious to one of ordinary skill in the art. See In re Stevens, 212 F.2d 197, 101 USPQ 284 (Cust. & Pat. App. 1954).



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9. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Greve in view of Schlör et al. (U.S. Pat. No. 4,853,087).

Greve teaches the apparatus as described above. Greve fails to teach a sealing member provided on the surface on which a mold clamping force is to be exerted or on the part of the net covering the peripheral part.

Schlör teaches a mold for producing products from wet fibers wherein the apparatus is provided with a seal (21) along a part peripheral to the molding cavity and in a mold clamping zone in order prevent molding materials from escaping the mold cavity (see figure 1).

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the apparatus of Greve as such to have provided a seal along a peripheral part of the molding cavity (and hence, on the part of the net covering the peripheral part) or in a mold clamping zone because this would have prevented molding material from escaping the molding cavity as suggested Schlör.

10. The following references are cited, but not relied upon, as being pertinent to the instant application:

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Mitchell (U.S. Pat. No. 2,149,878) teaches a pulp molding apparatus which uses two paired molds to form the molding cavity (see figures 8-10).


Chaplin (U.S. Pat. No. 2,471,032) teaches a pulp molding apparatus in which the net material (4) is not subject to a mold clamping force (see figure 3).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (703) 308-6371. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

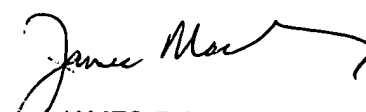
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker, can be reached at (703) 308-0457. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for responses to non-final action, and 703-872-9311 for responses to final actions. The unofficial fax phone number is (703) 305-3602.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Donald Heckenberg  
March 12, 2003



JAMES P. MACKEY  
PRIMARY EXAMINER  
3/17/03